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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,257	10/19/2000	Philip W. Miller	38-21(15771)B	7102

7590

06/03/2002

Lawrence M. Lavin, Jr.  
Patent Department, E2NA  
Monsanto Company  
800 N. Lindbergh Boulevard  
St. Louis, MO 63167

EXAMINER

HASHEMI, SHAR S

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 06/03/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/692,257

Applicant(s)

MILLER ET AL.

Examiner

Shar Hashemi

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/16/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, is drawn to a nucleic acid molecule that encodes a maize protein or fragment thereof, classified in class 536, subclass 23.1.
  - II. Claim 2, is drawn to a maize protein, classified in class 530, subclass 300.
  - III. Claims 3-7, are drawn to a transformed plant, classified in class 800, subclass 295.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group I is drawn to a nucleic acid molecule which may be used to hybridize to other nucleic acid molecules, to isolate promoters and flanking sequences, to influence expression, to act as markers. Group III is drawn to a transformed plant which may be used for agronomical purposes and seed production.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group I is drawn to a nucleic acid molecule which may be used to hybridize to other nucleic acid molecules, to isolate promoters and flanking sequences, to influence expression, to

Art Unit: 1637

act as markers. Group II is drawn to a maize protein which may serve as enzymes, structural elements, hormones, and immunoglobulins. Maize proteins may undergo disulfide bond formation, glycosylation, phosphorylation, and oligomerization.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different structures, different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group II is drawn to a maize protein which may serve as enzymes, structural elements, hormones, immunoglobulins. Maize proteins may undergo disulfide bond formation, glycosylation, phosphorylation, and oligomerization. Group III is drawn to a transformed plant which may be used for agronomical purposes and seed production.

Because these inventions are distinct for the reasons given above and the search required for each group is not required for the other groups, restriction for examination purposes as indicated is proper.

3. Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C 121. Absent evidence to contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, select to a restriction requirement pursuant to 35 U.S.C. 121 and CFR 1.141 et seq. Nevertheless, to further aid the biotechnology industry to protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided sua sponte to partially waive the requirements of 37 CFR 1.141 et seq. and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996).

4. It has been decided that, due to the high burden on the Office to search sequences, **ONE** sequence constitutes a reasonable number for examination purposes. **Applicant is further**

**required to elect ONE independent and distinct sequence.** Examination will be restricted to only the one elected sequence within each group. The search of no more than one selected sequences may include the complements of the selected sequence and where appropriate, may include subsequences within the selected sequence (e.g. oligomeric probes and/or primers).

It is noted that the claims recite the nucleic acid sequences in a Markush format. Restriction to one SEQ ID number is still appropriate here because the members of the Markush group lack unity of invention in that they do not share a substantial structural feature disclosed as being essential to the recited utility (See MPEP 803.02).

Applicant is reminded that upon cancellation of claims to a non-elected inventions, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

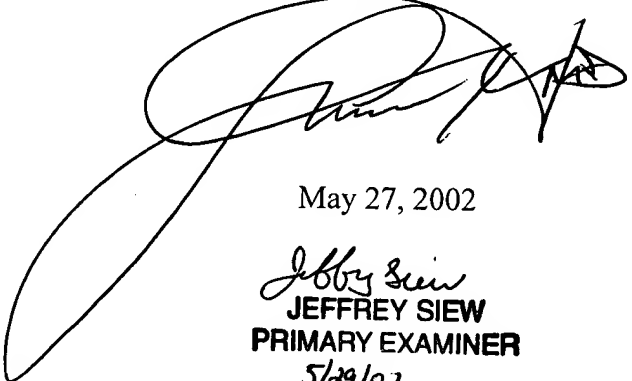
### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shar Hashemi whose telephone number is (703) 305-4840 and whose e-mail address is [shar.hashemi@uspto.gov](mailto:shar.hashemi@uspto.gov). However, the Office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner is on flex-time schedule and can be best reached on weekdays from 7:00 a.m. to 3:30 p.m. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Art Unit: 1637

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist for Technology Center 1600 whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Center numbers for Group 1600 are Voice (703) 308-1235 and Before Final FAX (703) 872-9306 or After Final FAX (703) 308-9307.



May 27, 2002

*Jeffrey Siew*  
**JEFFREY SIEW**  
**PRIMARY EXAMINER**  
5/29/02